

REMARKS

Priority Claim

Applicants wish to thank the Examiner for notifying them of the improper form of the "Related Applications" paragraph and have corrected the paragraph to place it in proper form. As all the related applications have already been fully incorporated by reference, no new matter has been added. The paragraph in its new form now properly depicts a chain of priority to U.S. Provisional Patent Application No. 60/182,330 filed on February 14, 2000.

Claims 1-26

Claims 1-26 were rejected under 35 USC 103(a) as being unpatentable over U.S. Patent No. 5,815,830 to Anthony ("*Anthony*") in view of "Exploring Representation Problems Using Hypertext by Catherine C. Marshall ("*Marshall*").

Under § 103, a *prima facie* case of obviousness can be established only if the cited references, alone or in combination, teach each and every element recited in the claim. *In re Bell*, 991 F.2d 781 (Fed. Cir. 1993). Applicants respectfully note that that none of the cited and applied references teach the elements of independent Claims 1 and 14. Claim 1 reads as follows:

1. (Original) A method for **dynamically constructing a sentence relating to a user request**, comprising:
 - receiving an indication of **concepts from a user**;
 - selecting related queries to present to the user based upon the concepts;
 - using the concepts to **construct a sentence relating to the user request**; and
 - selectively **repeating** the selecting step, based upon user input, in order to dynamically change the sentence.

(emphasis added)

Anthony, as the Examiner correctly points out, fails to teach constructing a sentence using concepts. Even more specifically, *Anthony* fails to teach, or even suggest "dynamically constructing a sentence relating to a user request," let alone dynamically constructing a sentence relating to a user request by repeated selections of related queries to a user based upon indications of concept from a user.

In turn, *Marshall* also fails to teach or suggest constructing a sentence using concepts. *Marshall* merely models arguments composed of other sentences (not concepts to build a sentence) using hypertext. See for example the separate sentences in each box of Figures 8, 9 and 10 of *Marshall*. As each of Claims 2-13 and 15-26 depend from either Claim 1 or Claim 14, they are also allowable for the same reason; as well as containing other elements not taught by *Anthony* or *Marshall*.

Additionally, the rejections of Claims 1-26 are predicated on combining prior art references that contain no teaching or suggestion of how the cited references could or should be combined to form the invention recited in the rejected claims. The Office Action fails to point out any teaching or suggestion in the references related to the **desirability** of the combination suggested in the Office Action. The rejection is using hindsight reasoning based on the **present disclosure** to "produce" the claimed invention by the mere combination of terms similar to those used in Claims 1-26. The references do not teach or suggest how they could be combined in any manner, much less the manner recited in the rejected independent claims. In this regard, the Examiner's attention is directed to the following Federal Circuit and C.C.P.A. decisions:

The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438, (Fed. Cir. 1991).

It is wrong to use the patent in suit as a guide through the maze of prior art references, combining the right references in the right way so as to achieve the result of the claims in suit. Monday morning quarterbacking is quite improper when resolving the question of nonobviousness in a court of law. *Orthopedic Equipment, Inc. v. United States*, 217 U.S.P.Q. 193, 199 (Fed. Cir. 1983).

Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination. Under Section 103, teachings of references can be combined **only** if there is some suggestion or incentive to do so.

ACS Hospital Systems, Inc. v. Montefiore Hospital, 221 U.S.P.Q. 929, 933 (Fed. Cir. 1984).

The *ACS Hospital Systems, Inc. v. Montefiore Hospital* decision has been cited with approval by the Federal Circuit. See *In re Geiger*, 2 U.S.P.Q. 2d 1276, 1278 (Fed. Cir. 1987). Similar statements have been made in many decisions of the Board of Appeals.

Nor do we see any suggestion in either of the references which would lead anyone having ordinary skill in the art to combine the structure taught by either reference with that taught by the other.

In order to justify a combination of references such as is here suggested it is necessary not only that it be physically possible to combine them, but the art should contain something to suggest the desirability of doing so. Since the art does not suggest the use of either of the patented devices for . . . there is nothing to indicate that one should be modified in view of the other for that purpose. *Ex parte Walker*, 135 U.S.P.Q. 195, 196 (Bd. App. 1962).

We have studied the references and the manner in which the examiner proposes to combine their teachings but we are unable to find in these references any suggestion that they should or could be combined, absent appellant's disclosure in the present application. *Ex parte Lennox*, 144 U.S.P.Q. 224, 225 (Bd. App. 1964).

While as an abstract proposition it might be possible to select features from the secondary references, as the examiner has done, and mechanically combine them with the Mallin device to arrive at appellant's claimed combination, we find absolutely no basis for making such combination neither disclosed nor suggested in the patents relied upon. **In our view only appellant's specification suggests any reasons for combining the features of the secondary references with the primary reference and under the provisions of 35 U.S.C. 103 that does not constitute a bar.** *Ex parte Fleischmann*, 157 U.S.P.Q. 155 (Bd. App. 1967). (Emphasis added.)

In the instant application, the examiner has done little more than cite references to show that one or more elements or subcombinations thereof, when each is viewed in a vacuum, is known. The claimed invention, however, is clearly directed to a combination of elements. That is to say,

appellant does not claim that he has invented one or more new elements but has presented claims to a new combination of elements. **To support the conclusion that the claimed combination is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed combination or the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references.** *Ex parte Clapp*, 227 U.S.P.Q. 972, 973 (Bd. App. 1985). (Emphasis added.)

In summary, Applicants submit that Claims 1-26 are clearly allowable in view of a lack of teaching or suggestion in the cited and applied references of how they could be combined in any manner, much less in the manner recited in these claims. Furthermore, even if the references were combinable in the manner discussed in the remarks accompanying the rejection of these claims, which Applicants specifically deny, the resultant combination would not meet all of the recitations of the claims, as noted above.

CONCLUSION

As a result, Applicants submit that all of the pending claims are in condition for allowance. Accordingly, a Notice of Allowance is respectfully requested. If the Examiner has any questions concerning the present paper, the Examiner is kindly requested to contact the undersigned at (206) 689-1216. If any fees are due in connection with filing this paper, the Commissioner is authorized to charge Deposit Account No. 500393.

Respectfully submitted,
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Date:

6/23/04

by:



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